

Remarks

The present Amendment is made in response to the October 31, 2007, and identified as Paper No. 20071029. Claims 1 and 4-17 are pending.

In the Action the Examiner rejected claim 7 under 35 U.S.C. § 102(b) as being anticipated U.S. Patent No. 2,843,267 to Anderson ("*Anderson*"). Claims 1 and 4-6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Anderson* in view of U.S. Patent No. 4,260,489 to Greig et al ("*Greig*") and U.S. Patent No. 3,438,502 to Schmidt, Jr. et al ("*Schmidt*"). Claims 8-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Anderson* as applied to claim 7 above and further in view of *Greig* and *Schmidt*.

I. Rejection of Claim 7

According to the Examiner, claim 7 recites a female connector mounted in the compartment, and *Anderson* inherently discloses a female connector mounted in the compartment because the reference expressly discloses a male connector 48 of the rack 14. A closer look at *Anderson* reveals that it fails to disclose either the male connector or a female connector in the compartment "such that said male connector engages said female connector when said rack is positioned within said compartment" as expressly recited in the claims. In particular, the Examiner's response to Applicant's prior argument that the open end 48 of the tube (erroneously called a male connector) must match with the cover 17 is based on an incorrect reading of *Anderson*, which does not disclose either a male connector or a female connector.

The structure identified by the Examiner as comprising a male connector (reference numeral 48) is simply a tubular member 45 having a closed end 47 and open end 48. Col. 4, lines 27-49. As specifically described at col. 4, lines 35-46, open end 48 ***remains open*** inside

the compartment so that liquid “may be withdrawn from the latter into through the open end 48 of tubular member 45.” Thus, *Anderson* does not disclose a male connector because the end of the tube is *never connected to anything*. Similarly, because the open end of tube 48 is never connected to anything, *Anderson* does not inherently disclose a female connector mounted in the compartment. As *Anderson* completely lacks the claimed male and female connectors that are in engagement when the rack is positioned in the compartment, the anticipation rejection is improper and should be withdrawn. MPEP 2131 (“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference”) (quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987)).

II. Rejection of Claims 1 and 4-6

In order to recreate the claimed invention from the prior art, the Examiner pointed to three separate references and picked and chose various elements from each of the three. The Examiner failed, however, to explain why one of ordinary skill in the art would have selected the particular components and rearranged them according to the proposed combination. This style of rejection is legally improper and is nothing more than a hindsight reconstruction of the invention.

As stated in MPEP § 2141, “[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.” The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court, quoting *In re Kahn*, 441 F.3d 977, 988, 78 U.S.P.Q.2d 1329, 1336 (Fed. Cir. 2006), stated that “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational

underpinning to support the legal conclusion of obviousness.” *KSR*, 550 U.S. at ___, 82 U.S.P.Q.2d at 1396.

Here, the Examiner simply pointed to where the elements recited in the claimed invention could be found in three separate references. The Examiner failed to provide any rationale or explanation why one of ordinary skill in the art would have found the proposed combination obvious, as specifically required by the MPEP and the Supreme Court. The obviousness rejection is therefore legally improper and should be withdrawn. MPEP 2143 (requiring explicit rationale for a *prima facie* case of obviousness).

As pointed out in Applicant’s prior reply, *Anderson* teaches upwardly positioned filter elements, while *Schmidt* teaches a downward configuration. The Examiner failed to address Applicant’s argument that these references could not be combined because *Anderson* would not work if modified according to *Schmidt* as it requires a completely opposite configuration. Accordingly, the proposed modification would violate the rule that the proposed modification cannot render the prior art unsatisfactory for its intended purpose. *See* MPEP § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984)). The Examiner failed to address this reason why the proposed combination is improper.

III. Rejection of Claims 8-17


As explained with respect to claims 1 and 4-6, the Examiner failed to provide any rationale why one of ordinary skill in the art would have made the proposed combination of various elements in the prior art. The obviousness rejection is therefore legally improper and should be withdrawn. MPEP 2143 (requiring explicit rationale for a *prima facie* case of obviousness).

Reply to Office Action dated April 8, 2008
Application No. 10/776,836
Amendment dated July 9, 2008

In view of the foregoing amendments as supported by these remarks, the Examiner's reconsideration and allowance of the present application is respectfully requested. If the Examiner believes that a telephone conference will expedite handling of the present application, please contact the undersigned at (315)218-8515.

Respectfully submitted,

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